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EXPRESS MAIL CERTIFICATE

"Express Mail" Label No. : EV 366 598 110 US

Serial No. : 09/920,707

Applicant(s) : Ben Byrd

Filing Date : August 2, 2001

Title : **Shoe Sole With Sizing Indicators**

Examiner : Marie D. Patterson

Group Art Unit : 3728

Type of Document(s) : Express Mail Certificate;
Transmittal Form;
Petition to Withdraw Holding of Abandonment Under
37 C.F.R. 1.181(a) (2 pages);
Amendment and Response Filed on May 14, 2004
(Attachments A, B, C and D) (23 pages); and
Return Postcard

I hereby certify that the documents identified above are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated below and are addressed to Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Debbie K. Cooke (signature)
Debbie K. Cooke

Date Mailed : July 26, 2004



07-28-04

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EV 366 598 110 US
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of : Ben Byrd
Serial No. : 09/920,707
Filed : August 2, 2001
For : Shoe Sole With Sizing Indicators
Examiner : Marie D. Patterson
Art Unit : 3728

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**PETITION TO WITHDRAW HOLDING OF ABANDONMENT
UNDER 37 C.F.R. 1.181(a)**

Dear Sir:

This petition is in response to a "Notice of Abandonment" mailed on June 23, 2004, in the above-identified patent application. Applicant respectfully petitions that the holding of abandonment be withdrawn.

The "Notice of Abandonment" states that the application is abandoned in view of Applicant's failure to timely file a proper reply to the Office letter mailed on November 14, 2003.

The undersigned hereby states that a proper reply to the Office Action mailed on November 14, 2003, was timely filed by Express Mail on May 14, 2004. *See Attachment A.* The customer receipt of the Express Mail label for the reply to the Office Action shows that the Express Mail package was given a "date in" of May 14, 2004. *See Attachment B.* A "Request for Extension of Time Pursuant To 37 CFR 1.136(a)" for a three-month extension of time to extend the time for reply to May 14, 2004, and the appropriate fee of \$950.00, were filed

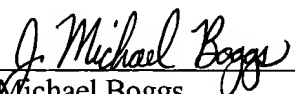
concurrently with the reply to the Office Action. *See* Attachment C. A return postcard for the reply to the Office Action was date-stamped by the U.S. Patent and Trademark Office as having been received on May 14, 2004. *See* Attachment D. Accordingly, Applicant respectfully submits that the reply to the Office Action was timely filed and that the reply to the Office Action was received by the U.S. Patent and Trademark Office.

Applicant respectfully submits that the "Amendment and Response Pursuant to 37 CFR § 1.111" filed on May 14, 2004, is fully responsive to the Office Action. *See* Attachment A. Therefore, Applicant respectfully submits that the reply to the Office Action was proper.

Accordingly, Applicant respectfully petitions that the holding of abandonment be withdrawn and that the reply to the Office Action filed on May 14, 2004, be considered. Applicant believes that no petition fee is required; however, please charge Account No. 16-1435 if a fee is due. The Office is respectfully invited to contact J. Michael Boggs at (336) 747-7536, to discuss any matter relating to this application.

Respectfully submitted,

Date: 7/26/04



J. Michael Boggs
Registration No. 46,563

Kilpatrick Stockton LLP
1001 West Fourth Street
Winston-Salem, NC 27101
(336) 747-7536
(336) 734-2632 (facsimile)

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**TRANSMITTAL
FORM**

(to be used for all correspondence after initial filing)

		Application Number	09/920,707
		Filing Date	August 2, 2001
		First Named Inventor	Ben Byrd
		Art Unit	3728
		Examiner Name	Marie D. Patterson
Total Number of Pages in This Submission	27	Attorney Docket Number	41872-206195

ENCLOSURES (check all that apply)

<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input checked="" type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Technology Center (TC) <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below): 1. Express Mail Certificate 2. Petition to Withdraw Holding of Abandonment 3. Amendment and Response filed on May 14, 2004 4. Return Postcard
<div style="border: 1px solid black; padding: 5px; width: fit-content;">Remarks</div>		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	J. Michael Boggs, Reg. No. 46,563
Signature	<i>J. Michael Boggs</i>
Date	7/26/04

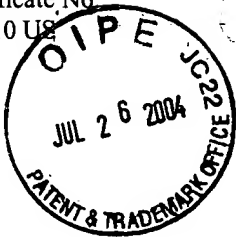
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Signature		Date	

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.





EXPRESS MAIL CERTIFICATE

"Express Mail" Label No. : EV 367 778 886 US **EV367778886US**
Serial No. : 09/920,707
Applicant(s) : Ben Byrd
Filing Date : August 2, 2001
Title : **Shoe Sole With Sizing Indicators**
Examiner : Marie D. Patterson
Group Art Unit : 3728
Type of Document(s) : Express Mail Certificate;
Transmittal Form;
Fee Transmittal for FY 2004 (*in duplicate*);
Request for Extension of Time Pursuant to
37 CFR 1.136(a) (*in duplicate*);
Amendment and Response Pursuant to 37 CFR § 1.111
(14 pages);
Check #361387 for \$950.00 – 3-Month Extension Fee; and
Return Postcard

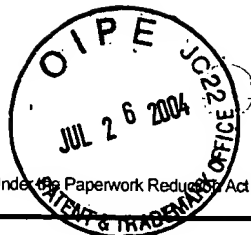
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Debbie K. Cooke (signature)
Debbie K. Cooke

Date Mailed : May 14, 2004

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41872-206195

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ON: 5/14/04 BY: KF



Express Mail Certificate No. EV 367 778 886 US

PTO/SB/21 (08-03)

Approved for use through 07/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

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**TRANSMITTAL
FORM**

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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/920,707	
	Filing Date	August 2, 2001	
	First Named Inventor	Ben Byrd	
	Art Unit	3728	
	Examiner Name	Marie D. Patterson	
Total Number of Pages in This Submission	16	Attorney Docket Number	41872-206195

ENCLOSURES (check all that apply)

<input checked="" type="checkbox"/> Fee Transmittal Form <input checked="" type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input checked="" type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): 1. Return Postcard
Remarks		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	J. Michael Boggs, Reg. No. 46,563
Signature	<i>J. Michael Boggs</i>
Date	5/14/04

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Signature		Date	

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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EV 367 778 886 US

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of : Ben Byrd
Serial No : 09/920,707
Filed : August 2, 2001
For : Shoe Sole With Sizing Indicators
Examiner : Marie D. Patterson
Art Unit : 3728

Mail Stop Amendment
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

AMENDMENT AND RESPONSE PURSUANT TO 37 CFR § 1.111

Dear Sir:

AMENDMENTS

This Amendment is being filed in response to an Official Action mailed November 14, 2003, in the above-identified application. Please amend the above-identified application as follows.

Amendments to the Claims are reflected in the listing of claims which begins on page 2 of this paper.

Remarks begin on page 9 of this paper.

LISTING OF CLAIMS

This listing of claims will replace all prior versions, and listings, of claims in this application:

1. (Currently Amended) A shoe for determining a proper numerical shoe size for a person's foot, the foot having a heel with a rear margin and toes with a forward margin, comprising:
 - an outsole having a heel portion, a forward portion, a length, and a width;
 - a heel placement indicator positioned on the heel portion; and
 - a plurality of shoe size indicators located on at least a portion of the width of the forward portion, each of the plurality of shoe size indicators located a distance from the heel placement indicator along the length of the outsole corresponding to a different numerical shoe size and labeled with the corresponding numerical shoe size;wherein the shoe sizes corresponding to the plurality of shoe size indicators comprise a range of standardized shoe sizes that approximate a size of the shoe, and
wherein when the rear margin of the person's heel is aligned with the heel placement indicator, the numerical shoe size immediately beyond the end of the forward margin on the person's toes indicates the proper numerical shoe size for the person's foot.
2. (Previously Amended) The shoe of claim 1, the shoe further comprising a heel portion inside the shoe, wherein the heel placement indicator is positioned on the outsole heel portion in alignment with the inside heel portion.
3. (Original) The shoe of claim 1, wherein each of the plurality of shoe size indicators further comprises a line located across at least a portion of the width of the outsole forward portion.
4. (Previously Amended) The shoe of claim 1, wherein the heel placement indicator and the plurality of shoe size indicators are molded into the outsole.

5. (Original) The shoe of claim 1, wherein the heel placement indicator and the plurality of shoe size indicators are printed onto the outsole.
6. (Canceled)
7. (Previously Amended) The shoe of claim 1, further comprising a left shoe or a right shoe.
8. (Original) The shoe of claim 1, further comprising a transparent material overlaying the outsole wherein the heel placement indicator and the plurality of shoe size indicators can be seen through the material.
9. (Previously Amended) The shoe of claim 1, wherein the plurality of shoe size indicators comprises standardized shoe sizes.
10. (Previously Amended) The shoe of claim 9, wherein the standardized shoe sizes comprise lengths and widths suitable for males or females.
11. (Previously Amended) The shoe of claim 10, the outsole further comprising images of (a) stuffed animals, toys, and stars, (b) numbers, letters of the alphabet, and geometric figures, (c) flowers, (d) sports characters, or (e) geometric patterns thereon.
12. (Currently Amended) A shoe for determining a proper numerical shoe size, comprising:
 an outsole having a heel portion, a forward portion, a length, and a width;
 a heel placement indicator positioned on the heel portion in alignment with a heel portion inside the shoe; and
 a plurality of shoe size indicator lines located across at least a portion of the width of the forward portion, each of the plurality of shoe size indicator lines located a distance from the heel

placement indicator along the length of the outsole corresponding to a different numerical shoe size and labeled with the corresponding numerical shoe size;

wherein the shoe sizes corresponding to the plurality of shoe size indicator lines comprise a range of standardized shoe sizes and lengths and widths suitable for ~~males or females~~ toddlers, pre-schoolers, girls, boys, women, or men.

13. (Original) The shoe of claim 12, further comprising a transparent material overlaying the outsole wherein the heel placement indicator and the plurality of shoe size indicator lines can be seen through the material.

14. (Currently Amended) A shoe size indication system for determining a proper numerical shoe size for a person's foot, the foot having a heel with a rear margin and toes with a forward margin, comprising:

an outsole having a heel portion, a forward portion, a length, and a width;

a heel placement indicator positioned on the heel portion; and

a plurality of shoe size indicators located on at least a portion of the outsole forward portion, each of the plurality of shoe size indicators located a distance from the heel placement indicator along the length of the outsole corresponding to a different numerical shoe size and labeled with the corresponding numerical shoe size;

wherein the shoe sizes corresponding to the plurality of shoe size indicators comprise a range of standardized shoe sizes that approximate a size of a shoe, and

wherein when the rear margin of the heel of the person's foot is aligned with the heel placement indicator and the person's toes are positioned to overlap the plurality of shoe size indicators, the numerical shoe size indicator immediately beyond the end of the person's toe forward margin indicates the proper numerical shoe size for the person's foot.

15. (Previously Amended) The shoe size indication system of claim 14, the shoe further comprising a heel portion inside the shoe, wherein the heel placement indicator is positioned on the outsole heel portion in alignment with the inside heel portion.

16. (Original) The shoe size indication system of claim 14, wherein each of the plurality of shoe size indicators further comprises a line located across at least a portion of the width of the outsole forward portion.

17. (Previously Amended) The shoe size indication system of claim 14, wherein the heel placement indicator and the plurality of shoe size indicators are molded into the outsole.

18. (Original) The shoe size indication system of claim 14, wherein the heel placement indicator and the plurality of shoe size indicators are printed onto the outsole.

19. (Canceled)

20. (Original) The shoe size indication system of claim 14, wherein the heel placement indicator and the plurality of shoe size indicators are placed on each of a left shoe or and a right shoe of a pair of shoes.

21. (Original) The shoe size indication system of claim 14, further comprising a transparent material overlaying the outsole wherein the heel placement indicator and the plurality of shoe size indicators can be seen through the material.

22. (Previously Amended) The shoe size indication system of claim 14, wherein the plurality of shoe size indicators comprises standardized shoe sizes.

23. (Previously Amended) The shoe size indication system of claim 22, wherein the standardized shoe sizes comprise lengths and widths suitable for males or females.

24. (Previously Amended) The shoe size indication system of claim 23, the outsole further comprising images of (a) stuffed animals, toys, and stars, (b) numbers, letters of the alphabet, and geometric figures, (c) flowers, (d) sports characters, or (e) geometric patterns thereon.

25. (Currently Amended) A shoe size indication system for determining a proper numerical shoe size for a person's foot, comprising:

an outsole having a heel portion, a forward portion, a length, and a width;

a heel placement indicator positioned on the heel portion in alignment with a heel portion inside the shoe; and

a plurality of shoe size indicator lines located across at least a portion of the width of the forward portion, each of the plurality of shoe size indicator lines located a distance from the heel placement indicator along the length of the outsole corresponding to a different numerical shoe size and labeled with the corresponding numerical shoe size;

wherein when the heel of the person's foot is aligned with the heel placement indicator and the person's toes are positioned to overlap the plurality of shoe size indicators, the shoe size indicator immediately beyond the end of the person's longest toe indicates the proper numerical shoe size for the person's foot;

wherein the heel placement indicator and the plurality of shoe size indicator lines are placed on each of a left shoe and a right shoe of a pair of shoes; and

wherein the shoe sizes corresponding to the plurality of shoe size indicator lines comprise a range of standardized shoe sizes and lengths and widths suitable for ~~males or females~~ toddlers, pre-schoolers, girls, boys, women, or men.

26. (Original) The shoe size indication system of claim 25, further comprising a transparent material overlaying the outsole wherein the heel placement indicator and the plurality of shoe size indicator lines can be seen through the material.

27. (Currently Amended) A method for determining a proper numerical shoe size for a person's foot, the person's foot having a heel with a rear margin and toes with a forward margin, comprising:

providing a shoe comprising an outsole having a heel portion, a forward portion, a length, and a width, a heel placement indicator positioned on the heel portion, and a plurality of shoe size indicators located on at least a portion of the outsole forward portion, each of the plurality of shoe size indicators located a distance from the heel placement indicator along the length of the outsole corresponding to a different numerical shoe size and labeled with the corresponding numerical shoe size, the shoe sizes corresponding to the plurality of shoe size indicators comprising a range of standardized shoe sizes that approximate a size of the shoe;

aligning the rear margin of the person's heel with the heel placement indicator;

positioning the person's toes to overlap the plurality of shoe size indicators; and

observing the location of the forward margin of the person's toes on the plurality of shoe size indicators;

wherein the shoe size indicator immediately beyond the end of the forward margin of the person's toes indicates the proper numerical shoe size for the person's foot.

28. (Previously Amended) The method for determining a proper size shoe for a person's foot of claim 27, the shoe further comprising a heel portion inside the shoe, wherein the heel placement indicator is positioned on the outsole heel portion in alignment with the inside heel portion.

29. (Original) The method for determining a proper size shoe for a person's foot of claim 27, wherein each of the plurality of shoe size indicators further comprises a line located across at least a portion of the width of the outsole forward portion.

30. (Canceled)

31. (Original) The method for determining a proper size shoe for a person's foot of claim 27, further comprising a transparent material overlaying the outsole wherein the heel placement indicator and the plurality of shoe size indicators can be seen through the material.

32. (Previously Amended) The method for determining a proper size shoe for a person's foot of claim 27, wherein the plurality of shoe size indicators comprises standardized shoe sizes.

33. (Previously Amended) The method for determining a proper size shoe for a person's foot of claim 32, wherein the standardized shoe sizes comprise lengths and widths suitable for males or females.

34. (Currently Amended) A method for determining a proper numerical shoe size for a person's foot, the person's foot having a heel with a rear margin and toes with a forward margin, comprising:

providing a shoe comprising an outsole having a heel portion, a forward portion, a length, and a width, a heel placement indicator positioned on the heel portion in alignment with a heel portion inside the shoe, and a plurality of shoe size indicator lines located on at least a portion of the outsole forward portion, each of the plurality of shoe size indicator lines located a distance from the heel placement indicator along the length of the outsole corresponding to a different numerical shoe size and labeled with the corresponding numerical shoe size, the shoe sizes corresponding to the plurality of shoe size indicator lines further comprising a range of standardized shoe sizes and lengths and widths suitable for ~~males or females~~ toddlers, pre-schoolers, girls, boys, women, or men;

aligning the rear margin of the person's heel with the heel placement indicator;

positioning the person's toes to overlap the plurality of shoe size indicators; and

observing the location of the forward margin of the person's toes on the plurality of shoe size indicators;

wherein the shoe size indicator immediately beyond the end of the forward margin of the person's toes indicates the proper numerical shoe size for the person's foot.

REMARKS

The following remarks are submitted to address the above amendments and issues raised in the Official Action mailed November 14, 2003.

A Request for Extension of Time for three months, extending the time in which to respond to this Official Action to May 14, 2003, along with the appropriate fee, is submitted herewith.

Upon entry of the foregoing amendments, claims 1-5, 7-18, 20-29, and 31-34 are pending in this application. Claims 1-5, 7, 9-12, 14-18, 20, 22-25, 27-29, and 32-34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Berger (U.S. Patent No. 5,084,988). Claims 8, 13, 21, 26, and 31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Berger in view of either Rosen (U.S. Patent No. 4,931,773) or Sigoloff (U.S. Patent No. 4,712,314).

These amendments are made merely to clarify the subject matter of this application. No new matter has been added. Support for requested amendments can be found in the original claims and throughout the present specification and drawings. Applicant respectfully requests consideration of the application in light of the above amendments and the following remarks.

Summary of Interview

Applicant thanks Examiner Marie D. Patterson for her telephone interview with the undersigned on May 11, 2004, in which features of the claims were discussed. Particular aspects of the present invention discussed include the lack of a transparent outsole in the claims as disclosed by Berger, a heel placement indicator positioned on the outsole in alignment with the inside heel portion, and a range of shoe sizes for determining a numerical shoe size as disclosed in the present specification and drawings.

Claims 1-5, 7, 9-12, 14-18, 20, 22-25, 27-29, and 32-34—35 USC § 103(a)

The rejections of claims 1-5, 7, 9-12, 14-18, 20, 22-25, 27-29, and 32-34 under 35 U.S.C. § 103(a) as being unpatentable over Berger are respectfully traversed.

Claims 1, 14, and 27, as amended, claim a shoe for determining a proper numerical shoe size for a person's foot, a shoe size indication system, and a method for determining a proper numerical shoe size for a person's foot in which "the shoe sizes corresponding to the plurality of shoe size indicators comprise *a range of standardized shoe sizes that approximate a size of the shoe.*" (Claims 1, 14, and 27, emphasis added.) Claims 12, 25, and 34, as amended, claim a shoe for determining a proper numerical shoe size for a person's foot, a shoe size indication system, and a method for determining a proper numerical shoe size for a person's foot in which "the shoe sizes corresponding to the plurality of shoe size indicator lines comprise *a range of standardized shoe sizes and lengths and widths suitable for toddlers, pre-schoolers, girls, boys, women, or men.*" (Claims 12, 25, and 34, emphasis added.)

The Official Action states that Berger shows shoe soles and methods of using shoe soles having a heel indicator and a plurality of calibrated lines with indicia comprising calibrated numbers and/or lines substantially as claimed except for the exact indicia, that standard shoe sizes are a type of well known and conventional calibrated marking, and that it would have been obvious to use any calibrated markings, including the well known and conventional shoe size calibrated markings, for the calibrated indicia on the shoe sole and in the method of Berger to allow the user to easily locate a shoe in the right shoe size range. (Official Action, para. 2.)

Berger discloses a shoe having a front transparent area within the outsole with calibrated markings, such as lines and/or numbers, that form a warning zone for indicating that a shoe has become too small. The shoe can also have a rear transparent area within the outsole through which heel location can be observed. The markings allow monitoring of the distance of the toe tips from the upper tip to see whether the shoe has become too small. (Berger, col. 1, line 38 –

col. 2, line 4; col. 3, lines 1-11.) A nontransparent edge in the front sole area can be used for calibration or marking of the “correct shoe size” by observing whether toe tips are present in the transparent area or grown into the nontransparent area. (Berger, col. 3, lines 62-68.)

“To establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” (MPEP § 2143.03.) Nowhere does Berger disclose “*a range of standardized shoe sizes that approximate a size of the shoe*”, as in claims 1, 14, and 27 of the present invention. Nowhere does Berger disclose “*a range of standardized shoe sizes . . . suitable for toddlers, pre-schoolers, girls, boys, women, or men*”, as in claims 12, 25, and 34 of the present invention. In contrast, Berger discloses a shoe having a front transparent area within the outsole with calibrated markings, such as lines and/or numbers, that form a *warning zone* for indicating that a shoe has become too small. As a result, Berger fails to disclose all the claim limitations of claims 1, 12, 14, 25, 27, and 34 of the present invention. Therefore, Applicant respectfully submits that claims 1, 12, 14, 25, 27, and 34 are not obvious in view of Berger. Claims 2-5, 7, 9-11, 15-18, 20, 22-24, 28-29, and 32-33 depend from claims 1, 12, 14, 25, and 27, and are therefore also not obvious in view of Berger.

“The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure.” (MPEP § 2142.) Applicant respectfully submits that there is no suggestion or motivation in Berger to modify its teachings to achieve “*a range of standardized shoe sizes that approximate a size of the shoe*”, as in claims 1, 14, and 27 of the present invention, or “*a range of standardized shoe sizes . . . suitable for toddlers, pre-schoolers, girls, boys, women, or men*”, as in claims 12, 25, and 34 of the present invention. The present invention provides for determining the proper numerical shoe size for a person’s foot that includes utilizing a range of standardized shoe sizes, including half sizes, as shown in Figs. 1-8, and in the shoe size tables on pages 11-13 of the present specification. Such a range can include a range of standardized shoe sizes for a particular age group, for example, toddlers, pre-schoolers, girls, boys, women, or men. (Present specification, page 15, line 20 – page 16, line 23.) In contrast, Berger teaches a *warning*

zone for indicating that a shoe has become too small, without respect to a particular shoe size or range of shoe sizes. Therefore, Applicant respectfully submits that Applicant's invention as claimed would not have been obvious to one having ordinary skill in the art with respect to Berger.

The Official Action states Berger shows features of the present invention substantially as claimed except for the exact indicia, and that claims are allowed only where they define either new features of structure or new relations of printed matter to structure, which new features or new relations give rise to some new and useful function, effect, or result. (Official Action, para. 2.) Applicant respectfully submits that shoe size indicators and a range of standardized shoe sizes as claimed in the present invention provide a structure on the outsole of a shoe that advantageously allows determination of a proper numerical shoe size for a person's foot. Accordingly, the claims of the present invention define new features of structure or new relations of printed matter to structure that give rise to a new and useful function and result. Therefore, Applicant respectfully submits that the claims of the present invention should be allowed.

For all of these reasons, the Office is respectfully requested to withdraw the rejections of claims 1-5, 7, 9-12, 14-18, 20, 22-25, 27-29, and 32-34 under 35 USC § 103(a).

Claims 8, 13, 21, 26, and 31—35 USC § 103(a)

The rejections of claims 8, 13, 21, 26, and 31 under 35 U.S.C. § 103(a) as being unpatentable over Berger in view of either Rosen or Sigoloff are respectfully traversed.

The Official Action states that Berger, as modified/discussed in the Official Action, shows a shoe sole and method of using such substantially as claimed except for providing a transparent layer over the bottom of the outsole, that Rosen or Sigoloff teaches providing a transparent layer on an outsole over an area of indicia, and that it would have been obvious to

provide a transparent layer as taught by Rosen or Sigoloff in the shoes and method of Berger to increase the durability and to make the indicia easier to read after the shoes have been worn. (Official Action, para. 3.)

As discussed herein, Applicant respectfully submits that Berger fails to disclose all the claim limitations of claims 1, 12, 14, 25, 27, and 34 of the present invention, as amended, and is therefore deficient as a reference with respect to these independent claims. Claims 8, 13, 21, 26, and 31 depend from claims 1, 12, 14, 25, and 27, and are therefore also not obvious in view of Berger. Neither Rosen or Sigoloff cure the deficiencies of Berger as a reference by teaching or suggesting “*a range of standardized shoe sizes that approximate a size of the shoe*”, as in claims 1, 14, and 27, or “*a range of standardized shoe sizes . . . suitable for toddlers, pre-schoolers, girls, boys, women, or men*”, as in claims 12, 25, and 34. Thus, Applicant respectfully submits that claims 8, 13, 21, 26, and 31 are not obvious over Berger in view of either Rosen or Sigoloff.

For all of these reasons, the Office is respectfully requested to withdraw the rejections of claims 8, 13, 21, 26, and 31 under 35 USC § 103(a).

CONCLUSION

Applicant submits that a full and complete response has been made herein to the Official Action and, as such, all pending claims in this application are now in condition for allowance. Therefore, Applicant respectfully requests early consideration of the present application, entry of all amendments herein requested, withdrawal of all rejections, and allowance of all pending claims.

The Office is respectfully invited to contact J. Michael Boggs at (336) 747-7536, to discuss any matter relating to this application.

Respectfully submitted,

5/14/04
Date

J. Michael Boggs
J. Michael Boggs
Reg. No. 46,563

Kilpatrick Stockton LLP
1001 West Fourth Street
Winston-Salem, NC 27101
(336) 747-7536
(336) 734-2632 (facsimile)

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ATTACHMENT B



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J. Michael Boggs, Esq.
41872-206195

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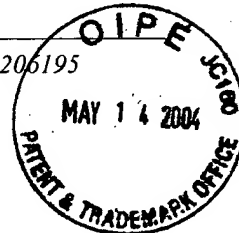
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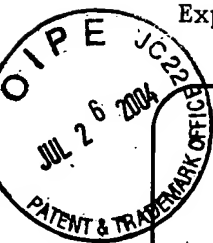
In re applic. of: Ben Byrd
For: Shoe Sole With Sizing Indicators
Serial No.: 09/920,707
Express Mail Number: EV 367 778 886 US

The Following Was Received by the PTO:

- ☒ Express Mail Certificate (EV 367 778 886 US);
- ☒ Transmittal Form;
- ☒ Fee Transmittal for FY 2004 (*in duplicate*);
- ☒ Request for Extension of Time Pursuant to 37 CFR 1.136(a) (*in duplicate*);
- ☒ Amendment and Response Pursuant to 37 CFR 1.111 (14 pages);
- ☒ Check No. 361387 for \$950.00 – 3-Month Extension Fee; and
- ☒ Return Post Card

Date Mailed to PTO: May 14, 2004 -- Client Matter No.: 41872-206195





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**FEE TRANSMITTAL
for FY 2004**

Effective 10/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27**TOTAL AMOUNT OF PAYMENT** (\$) 950**Complete If Known**

Application Number	09/920,707
Filing Date	August 2, 2001
First Named Inventor	Ben Byrd
Examiner Name	Marie D. Patterson
Art Unit	3728
Attorney Docket No.	41872-206195

METHOD OF PAYMENT (check all that apply)☒ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None☒ Deposit Account:Deposit Account Number
16-1435Deposit Account Name
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The Director is authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☒ Credit any overpayments
☒ Charge any additional fee(s) during the pendency of this application
☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.**FEE CALCULATION****1. BASIC FILING FEE**

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	770	2001	385	Utility filing fee	
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	
SUBTOTAL (1)					(\$ 0)

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims		-20 **	=	0	X		=	0
Independent Claims		-3 **	=	0	X		=	0
Multiple Dependent					X		=	0

Large Entity		Small Entity		Fee Description
Fee Code	Fee (\$)	Fee Code	Fee (\$)	
1202	18	2202	9	Claims in excess of 20
1201	86	2201	43	Independent claims in excess of 3
1203	290	2203	145	Multiple dependent claim, if not paid
1204	86	2204	43	** Reissue independent claims over original patent
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$ 0)

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)**3. ADDITIONAL FEES**

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1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet.	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	475	Extension for reply within third month	950
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1,005	Extension for reply within fifth month	
1401	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing a brief in support of an appeal	
1403	290	2403	145	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,330	2453	665	Petition to revive - unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17 (q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	2809	385	Filing a submission after final rejection (37 CFR § 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR § 1.129(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify) _____

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$ 950)**SUBMITTED BY****Complete (if applicable)**

Name (Print/Type)	J. Michael Boggs	Registration No. (Attorney/Agent)	46,563	Telephone	(336) 747-7536
Signature	<i>J. Michael Boggs</i>	Date	5/14/04		

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of : Ben Byrd
Serial No : 09/920,707
Filed : August 2, 2001
For : Shoe Sole With Sizing Indicators
Examiner : Marie D. Patterson
Art Unit : 3728

Mail Stop Amendment
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR EXTENSION OF TIME PURSUANT TO 37 CFR 1.136(a)

Dear Sir:

Applicant respectfully requests a three month extension of time in which to respond to the Official Action mailed November 14, 2003, in the above-identified application. This extension of time will extend the period for filing to expire on May 14, 2004.

Enclosed is a check including \$950.00 for the extension fee. The Commissioner is also hereby authorized to charge any additional fees required by this action, or credit any overpayment, to Deposit Account No. 16-1435. A duplicate of this sheet is enclosed for that purpose.

The Office is respectfully invited to contact J. Michael Boggs at (336) 747-7536, to discuss any matter relating to this application.

Respectfully submitted,

5/14/04

Date

J. Michael Boggs
J. Michael Boggs
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Serial No. 09/920,707

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